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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/667,420
Filing Date: September 21, 2000
Appellant(s): OKAMOTO ET AL.

Ningling Wang
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/23/05 appealing from the Office action mailed 03/24/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

11-021227 YAKUTA (Japanese Patent) 1-1999

5,976,510 CERNASOV 11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-4, 6-10 and 18-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-021227 (English Translation relied on) and Cernasov et al. (US 5,976,510).

JP 11-021227 discloses a gel composition comprising 1.0-80.0 weight percent polyacrylamide, Vaseline or ceresin, 0.1-20.0 weight percent polyoxyethylene sorbitan fatty acid ester as the non-ionic surfactant and organopolysiloxane (English abstract and paragraph 0004).

The JP reference in the translation provided by applicants suggests that pigments and fillers may be used in the gel composition and embodiments 4 and 5 contain pigments and talc and mica. The JP-I 11-021227 translation teaches that the desired cosmetic formulation is one that does not run off from hands or face and one that is not sticky, a composition that refreshes (paragraphs 0003 and 0004) and one that would retain moisture by containing moisture retention agent and formulations further contain inorganic pigments or colorants, pearl agent, antioxidants and ultraviolet light absorber (paragraph 0019 and embodiments 4 and 5). The sepiigel in embodiments 4 and 5 is polyacrylamide-based polymer. The JP reference does not disclose the pigments to be surface treated.

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However, Cernasov discloses cosmetic tanning and sunscreen composition that is water repellant, stable and moisturizing (abstract). The composition of Cernasov contains inorganic pigments that are treated with perfluoroalkyl phosphates or (column 1, lines 32-67 and examples 1-3) and perfluoroalkyl phosphate is perfluoroalkyl phosphate diethanolamine salt listed by applicants' specification (at page 5, lines 3-6) as water repellant and oil repellant agent. Cernasov in column 2, lines 63-67 discloses that the combination of pigments treated with perfluoroalkyl phosphates and dispersants and selected oily phase provides surprisingly "significantly higher moisture content for the skin."

Both Cernasov and the JP reference disclose cosmetic composition and are thus in the same field of endeavor. Two compositions, "each of which is taught in the prior art to be useful for the same purpose" can be combined "to form a third composition to be used for the very same purpose," according MPEP 2144.06. "[T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626, F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare the combined composition of Cernasov and the JP reference. One having ordinary skill in the art would have been motivated to do so with the expectation that the combined composition would be effective for the very same purpose as cosmetic and the combined composition would have excellent water-repellant, oil-repellant characteristics.

Regarding claims 1, 35, 37, 38 and 40, the combined combination contains the surface treated pigments; specific examples of the surface treated pigments are titanium oxide, red iron oxide, yellow iron oxide, black iron oxide, all of which are treated with perfluoroalkyl phosphate

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(examples 1-3 of Cernasov). Therefore, the combined composition contains surface treated pigments of claims 2-4, 6-8, 18, 19 and 41 and specifically examples 1 and 2 of Cernasov discloses perfluoroalkyl phosphate treated pigments in amounts of 7.7% and 11.1% respectively, thereby meeting the amounts of the surface treated pigment of claims 18 and 19. In one embodiment, the combined composition of Cernasov and the JP reference contains about 5% of pigments not-surface-treated since embodiment 4 of the JP reference discloses composition having about 5% of pigments and thus meets the limitation of claim 20. The cosmetic composition of the JP reference contains about 1.0 to 60% hydrocarbon (paragraph 0016) and liquid paraffin, petroleum jelly, ceresin, squalen are some examples of the paraffin used in the composition and thus the combined composition meets the limitations of claims 24-28. The combined composition of Cernasov and the JP reference also contains pigments that have not been surface treated and therefore, meets the limitations of claim 20. Claim 21-23, 31, 32 and 34 read on the combined composition because the composition of the JP reference contains from 1.0% - 80% polyacrylamide based polymer. The composition of the JP reference contains non-ionic surfactant in amounts of 0.1-20 wt% as stated above and thus claims meets claims 24, 25, 29 and 30. Regarding claims 9, Cernasov discloses treating the surface of pigments with perfluoroalkyl phosphate diethanolamine salt and regarding claim 10, one fluoro-treated pigment may be replaced with another fluoro-treated pigment without loss of the beneficial effect of moisture retention.

Regarding claim 33, paragraph 0033 of the JP reference does not list the presence of oil in the gel composition. However, the JP reference in paragraph 0019 discloses that the cosmetic composition may contain oil and in the absence of a factual evidence of unusual results, 10 wt%

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amount of oil recited in claim 33 does not patentably distinguish the invention over the composition of the JP reference that discloses inclusion of oil in the cosmetic composition, which is not sticky, which refreshes (paragraphs 0003 and 0004) and a composition that would retain moisture.

Regarding claim 36, the JP reference discloses the inclusion of pigments or colorants, pearl agent, **antioxidants and ultraviolet light absorber** (paragraph 0019 and embodiments 4 and 5) in the cosmetic composition.

Regarding claim 39, the JP reference discloses that the cosmetic composition is a beauty liquid, makeup foundation, eye shadow or rouge and makeup foundation and eye shadow are for the application to the face and eyes.

(10) Response to Argument

A) Appellants argue that claims 1-4, 6-10 and 18-40 are patentable over the JP reference and Cernasov because:

i) a prima facie case of obviousness has not been established in view of lack of “suggestion or motivation to modify or combine the references or evidence of a reasonable expectation of success from any such modification or combination.”

Appellants’ argument A i) is not persuasive because the JP composition and the Cernasov composition are useful for cosmetic applications and the cosmetic products are individually disclosed by the prior art. “[T]he idea of combining them flows logically from their having been individually taught in the prior art. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.” *In re Kerkhoven*, 626 F.2d 846, 850, 205

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USPQ 1069, 1072 (CCPA 1980). The motivation is that the third composition would be expected to be cosmetic composition that would retain moisture and a composition that would not stick.

ii) there is a lack of requisite evidence of a suggestion or motivation to modify the composition of the JP reference by including the perfluoroalkyl phosphate treated pigments of Cernasov in order to arrive at the presently claimed invention by picking and choosing the perfluoroalkyl phosphate treated pigments from the composition disclosed in Cernasov and use them in the composition disclosed in the JP reference.

Appellants' argument A ii) is not persuasive because the issue is not a picking and choosing but here a specific pigment taught in the prior art (Cernasov) to have the advantage of significantly providing higher moisture content to the skin (column 2, lines 61-67 of Cernasov) is selected. Thus the suggestion is a pigment that results "in a significantly higher moisture content for the skin" (Cernasov at column 2, lines 65 and 67). The motivation is to produce a cosmetic that would retain moisture and expectation that the composition would retain moisture on the skin.

iii) there is lack of reasonable expectation of success because Cernasov while disclosing that "well-balanced composition is essential to achieving a stable emulsion ... because individual components with frequently conflicting characteristics must be integrated into such an emulsion," discloses that pigments treated with perfluoroalkyl phosphate "acquire water and oil-repellant characteristics" and "the subsequent processing in certain cosmetic products is not generally possible due to water and oil-repellant characteristics; and thus, appellants conclude that, Cernasov recognizes that "one cannot simply pick and choose one ingredient in one

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composition and combine it or the composition itself with another composition without potentially changing the nature and stability of the final products.”

Appellants’ argument A iii) is not persuasive because column 1, lines 10-14 cited by appellant is the prior art where components with conflicting characteristic are integrated into such emulsions and as such a well balanced composition is essential to achieving stable emulsion and Cernasov in that section was presenting the state of the prior art and problem that needed to be solved. Therefore, in column 1, lines 31-37, Cernasov presents the object of providing a stable oil-in-water emulsion composition that contains pigments and a composition “that offers excellent moisture-retention characteristics without significant moisturizing additives, as well as excellent water-repellent characteristics when the emulsion is applied to the skin.” The pigments of Cernasov are perfluoroalkyl phosphates treated colored iron oxides (yellow, black or red iron oxide or mixtures thereof), titanium dioxide and the mixtures thereof (column 1, lines 42-45 and 64-66). Specifically, the section referred to by appellants, that is, column 1, line 58 to column 2, line 3, Cernasov discloses treating pigments with perfluoroalkyl phosphate diethanolamine salt, and that the so treated pigments, yellow, black or red iron oxide or mixtures thereof and titanium dioxide acquire water and oil-repellant characteristics (column 2, lines 58-66). In column 2, lines 1-3, Cernasov states that “the subsequent processing in certain cosmetic products is not generally possible due to the water and oil-repellent characteristics.” Appellants’ conclusion that, Cernasov recognizes that “one cannot simply pick and choose one ingredient in one composition and combine it or the composition itself with another composition without potentially changing the nature and stability of the final products” is not found in the cited lines. On the contrary, Cernasov specifically discloses the disadvantages of using untreated pigments

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in cosmetics for the skin due to strong drying effect on the skin and also that large amounts of moisturizers are generally required when untreated pigments are used (column 2, lines 61-63); and specifically discloses the advantages of using perfluoroalkyl phosphate treated pigments (column 2, lines 66 and 67).

Therefore, there is no picking and choosing but a selection of specific pigment disclosed by Cernasov to provide higher moisture content for the skin. One of the goals of the JP reference is a composition that would retain moisture on the skin.

iv) the 132 declaration provides valid evidence of non-obviousness and that Examiner is wrong to have indicated that declaration was attacking references individually and that MPEP 716.02 clearly indicates that “evidence of unexpected results must compare the claimed invention with the closest prior art, [but] applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art.”

It is noted that the declaration is not commensurate in scope with the claims because the claims are generic to pigment surface treated with broad fluorine compound while the comparison provided in the declaration is directed to single specified fluorine compound; secondly, the prior art Cernasov discloses that pigments treated with perfluoroalkyl phosphates “surprisingly results in a significantly higher moisture content for the skin than was thought to be possible” (column 2, lines 65-67), thus the results are expected.

B) Appellants argue that claim 1 is patentable over the JP reference and Cernasov because “Examiner failed to show that the combination of the JP reference and Cernasov teach or suggest all limitations of the present claim 41 and that the JP reference and Cernasov, either alone or in combination do not teach or suggest “a process for stabilizing a gel composition” and

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further that Examiner failed to point to any evidence of a suggestion or motivation to combine the references nor any evidence of a reasonable expectation of success from any such combination,” as appellants discussed in subsection A.

Appellants’ argument B is not persuasive because

- i) the holding of an obviousness rejection does not require absolute predictability,
- ii) the process of claim 41 stabilizes the gel composition by including in the gel composition an effective amount of at least one gelling agent comprising at least one polyacrylamide-based polymer and at least one ingredient surface treated with at least one fluorine compound, where the at least one ingredient is chosen from pigments and fillers. Cernasov and the JP reference are in same field of cosmetic endeavor and both compositions provide for moisture retention on the skin. Reference compositions in same field of endeavor can be combined to form a third composition for use in the same field of endeavor (*in re Kerkhoven*). One of the objects of Cernasov is to provide stable composition containing inorganic pigments that offer excellent moisture retention characteristics (column 1, lines 31-37). To achieve the foregoing, Cernasov includes perfluoroalkyl phosphate treated pigments and part 2 of claim 41 reads on Cernasov. The JP reference discloses cosmetic composition that comprises gelling agent that is based on polyacrylamide. Thus the combined references disclose all the limitations of claim 41, which is the steps of adding gelling agent and surface treated pigments, both of which is disclosed in the combined reference. An effective amount reads on any amount deemed effective by the person of ordinary skill. The comprising language of the claim is open.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


BF



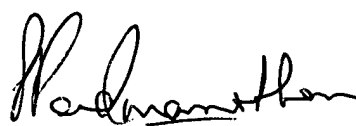
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